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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85627251
Applicant	4162 Doerr Road, Inc. dba Marshall Distributing, Inc.
Applied for Mark	SOLO
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Before the Trademark Trial and Appeal Board**

MARK: Solo
SERIAL NO: 85/627251
APPLICANT: 4162 Doerr Road, Inc.
FILING DATE: May 16, 2012

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I. INTRODUCTION

Applicant appeals from the Examiner's refusal to register the above-identified mark and requests that the TTAB reverse the Examiner's decision.

II. APPLICANT'S TRADEMARK

Applicant seeks registration of the mark "Solo" on the Principal Register for use with "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks."

III. GROUNDS FOR REFUSAL TO REGISTER

Both in a final Office Action dated March 23, 2013, and in a denial of a Request for Reconsideration dated October 15, 2013, registration of the Solo mark was refused on the grounds that there may be a likelihood of confusion under Section 2(d) of the Act between Applicant's mark and Registration Nos. 2927554 and 3579672.

IV. ISSUE PRESENTED

The issue presented by this appeal is whether there is a likelihood of confusion between Applicant's mark "Solo" and Registrations 2927554 and 3579672.

V. ARGUMENT

Applicant is a wholesale distributor of ATV, motorcycle, and snowmobile parts. Applicant also distributes a large selection of motorsport accessories, including parts and apparel. Applicant's mark, "SOLO," is for "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks" which it has been using in commerce since at least as early as April 2008.

Registration No. 2927554 is for the mark "SOLO" in a stylized form for "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats.". It is owned by Semore, Inc., which according to its website,

<http://www.solojeansla.com/about/>, sells men's designer jeans. Registration No. 3579672 is for the mark "SOLO" in a stylized form for "footwear."

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Pub 'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.").

In assessing whether there is a likelihood of confusion under Section 2(d), the following factors, known as the *duPont* factors, must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i. e., whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A.

1973); see also TMEP § 1207.01(b). The majority of the factors cut against a finding of likelihood of confusion in this case.

While Applicant's mark and the Registrants' marks may be nearly identical, there is no likelihood of confusion for the following reasons: the marks are all used in the very broad category of clothing for very different clothing; the goods do not travel in the same trade channels; Applicant's goods are purchased by sophisticated purchasers; the Registrants' marks are not famous and thus, are not afforded extra protection; Applicant's mark is merely one of a crowd of marks for clothing; there are no known instances of actual confusion; and the marks have co-existed peacefully for at least five years. Thus, consumers are unlikely to be confused as to the source of origin of the goods.

1. Although the Marks Are Nearly Identical, Confusion is Unlikely

The first factor in determining whether there is a likelihood of confusion is to compare the marks in their entireties for similarities in their appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); see also TMEP § 1207.01(b). Similarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1043 (TTAB 1987); see also TMEP § 1207.01(b)(i).

The test is whether the goods are similar enough that a customer would assume they were offered by the same source. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270 (3rd Cir. 2001) (finding no likelihood of marketplace confusion where two companies used identical marks in same industry). Mere use of identical marks, even if used in the same broad industry, does not demonstrate likelihood of confusion. *Id.*, see also *Astra*

Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201 (1st Cir. 1983) (finding no confusion where two products were part of distinct sectors of a broad product category because consumers were not likely to assume the products originated from the same source).

Mere use of identical marks, even if used in the same broad industry, does not demonstrate likelihood of confusion. *Id.*, see also *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983). In *Astra*, applicant applied for registration of the mark “ASTRA” in connection with computerized blood analyzer machines and products associated therewith. Registrant had five active registrations for “ASTRA” in connection with pharmaceutical products and syringes. The Registrant sued for trademark infringement and the District Court’s dismissal of the suit on summary judgment was upheld by the Court of Appeals, who agreed that there was no likelihood of confusion of the source of the products, even though those products emanated from the same broad category of products used in the medical health field. *Id.* at 1205-1206.

While Applicant’s mark and the Registrants’ marks may be nearly identical, they are both used in the very broad category of clothing and they do not travel in the same trade channels. In addition, both Registrants’ marks are in stylized form. Thus, consumers are unlikely to be confused as to the source of origin of the goods.

2. Applicant and Registrants’ Goods Are Not Similar and Thus, Confusion is Not Likely

While Applicant’s mark and Registrants’ marks may be nearly identical, Applicant’s goods are distinct and separate from those identified by the Registrants and thus, consumer confusion is unlikely.

Registration no. 2927554 is for everyday, casual clothing items, such as jeans, while Applicant's mark is for a very specialized type of clothing necessary specific to power sports functions and not used as casual wear. The snowmobile, motorcycle and ATV clothing is designed to be worn while riding these off-road vehicles and it is specifically designed to protect the rider. For example, the pants have leather inner leg patches to protect the rider's legs from being burned on exhaust pipes. The pants also have larger knee areas to accommodate knee and shin pads that are commonly worn by riders. Gloves are likewise designed specifically for sport use with different types of grips, padded palms and spandex back panels, and are very different depending on what type of vehicle you are riding, i.e., snowmobile, motorcycle or ATV. Even the socks are specially designed to have a padded toe and heel and arch and ankle support. In other words, Applicant's clothing is sport-specific and would never be confused with casual clothing.

Registration no. 3579672 is for footwear. Applicant has sought to register its mark for boots used in snowmobile, motorcycle and ATV riding. Again, Applicant's boots are not casual wear boots. They are specifically designed to be worn while riding a snowmobile, motorcycle or ATV. Some of the design elements included a leather heat shield, a steel shank for sole support during motorcycle racing and a steel toe guard. It is unlikely that Applicant's sport-specific boots would be confused with Registrant's casual footwear.

There can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (regarding alcoholic beverages); *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*,

4 USPQ2d 1169, 1171–72 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (regarding clothing).

For example, in *In re British Bulldog, supra*, in a “close” call, the Board reversed the refusal to register the design mark “PLAYERS” for men’s underwear based on a likelihood of confusion with an existing registration for the mark “PLAYERS” for shoes. The Board noted that while “it is true that the goods in question, namely, men's underwear and shoes, are items of wearing apparel to be sold in the same stores to the same classes of purchasers,” “they are distinctly different when sold in the same stores” in terms of their placement in the store and how each product is purchased, i.e., underwear is an “off-the-shelf” item whereas shoes are typically purchased with the assistance of a salesperson. *Id.* at 856.

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). The examining attorney has not met his burden in this case.

3. Applicant and Registrants’ Goods Do Not Travel in the Same Trade Channels and Thus, Consumer Confusion is Not Likely

Due to the specific nature and use of Applicant’s goods, it is unlikely that Applicant and Registrants share actual or potential purchasers sufficient to cause confusion. Not only are the actual goods of the Registrants and Applicant very different, but those goods likewise travel in different channels of trade and are not likely to be encountered by the same consumers. There is

no likelihood of confusion when similar marks are used in different markets of the same broad field. *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992). Registrants' casual clothing and footwear are marketed and sold to a different class of consumers than those which Applicant markets its specialized sport clothing too. Applicant markets and sells its specially designed clothing to snowmobile, motorcycle and ATV enthusiasts and competitors. Although Registrants and Applicant's goods fall within the broad field of clothing, those goods could not be more different and are each marketed to, and purchased by, a completely different class of purchasers.

In addition, even where the marks are identical, if the goods or services in question are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then confusion is not likely. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

While it is acknowledged that the Applicant's goods and Registrants' goods fall within the same broad category of clothing, they are indeed very different, are marketed to different consumers and are purchased by different consumers. Applicant's goods are not sold at

department or other casual clothing stores. Applicant's specialized clothing can only be purchased through authorized dealers who specialize in selling snowmobile, motorcycle and ATV parts and clothing, or through Applicant's catalog and/or website, which is marketed to snowmobile, motorcycle and ATV enthusiasts.

4. Applicant's Goods are Bought by Sophisticated Purchasers and Thus, Consumer Confusion is Unlikely

Applicant's products are bought by sophisticated purchasers, which undercuts any likelihood of confusion. "Where the ... buyer class consists of sophisticated or professional purchasers, courts have generally not found Lanham Act violations." *Checkpoint Systems*, 269 F.3d at 284. Purchasers' sophistication is important and often dispositive because "[s]ophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales*, 954 F.2d 713 (Fed. Cir. 1992) (citations omitted). Likelihood of confusion must be shown to exist in an actual or potential purchaser. *Id.* at 717. Sophisticated consumers would not overlook the marked and distinct differences between Applicant's specialized sport clothing and Registrants' everyday casual clothing and footwear. Thus, they are unlikely to be confused about Registrants' and Applicant's marks.

5. Registrants' Marks are not Famous

Neither of the registrations on which the Examiner's likelihood of confusion is based are famous marks. According to *du Pont*, the "fame of the prior mark" is a factor to be considered in determining likelihood of confusion. 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks are afforded a broad scope of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d

1689, 1694 (Fed. Cir. 2005). However, like the other *du Pont* factors, the fame of a mark may be considered only if there is relevant evidence of record. TMEP § 1207.01.

In the instant matter, the Registrants' marks for "Solo" are not famous, nor has any evidence been submitted showing any alleged fame. In fact, the first dates of use for both registrations would cut against a finding of fame. The first date of use for Registration No. 2927554 is January 2003 and the first date of use for Registration No. 3579672 is February of 2008.

6. There are Many Marks for Clothing Which Use the Term "Solo"

The presence of multiple marks that use the word "solo" with regard to clothing, is evidence that "it is merely one of a crowd of marks." 2 McCarthy on Trademarks, § 11:85 (4th ed. 2008). In such a crowd, consumers will not be confused between any two similar marks and may have learned to carefully pick out one from the other. *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385 (T.T.A.B. 1976). Such a finding applies to this case, as evidenced by the following list of registered marks which contain the term "solo" for goods in the broad category of clothing:

- LOBO SOLO, Registration No. 4358788, for "Clothing, namely, shirts, t-shirts, pants, shorts, and sweatshirts."
- KORET SOLOS, Registration No. 2925465, for "Women's clothing, namely, blouses, skirts, shorts, skorts, pants, sweaters, tops, dresses, suits, vests, jackets and coats."
- SOLO MODA (with MODA disclaimed), Registration No. 4307130, for "Clothing, in the nature of athletic, exercise, casual and outdoor winter clothing, namely, shirts, trousers, pants, jackets, T-shirts, tops, coats, jerseys, belts, socks,

sweaters, sweatshirts, vests, socks, blouses, dress suits, dresses; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms, coats; formalwear, namely, suits, dress suits, dresses, pants, shirts, blouses; loungewear, beachwear, rainwear, sleepwear, and undergarments.”

- SOLO THE CAT, Registration No. 3848218, for “Clothing and apparel, namely, hats, socks, and shirts.”
- SOLO NOVE, Registration No. 3423837, for “Clothing, namely, shirts, T-shirts, polo shirts, pants, trousers, sweaters, jump suits, tops, tank tops, halter tops, sweat pants, warm-up suits, jogging suits, blouses, skirts, dresses, blazers, turtlenecks, not sold through or associated with restaurants or food service establishments.”
- SOLOS KORET, Registration No. 2042095, for “women's clothing, namely, skirts, pants, shirts, jackets and tops.”

Based on the above evidence, it is clear that Applicant’s mark “Solo” as it relates to clothing is merely “one in a crowd of marks.” Thus, consumer confusion is not likely.

7. There are No Known Instances of Actual Confusion

Applicant is not aware of any known instances of actual confusion between its mark and the Registrations. In fact, all three marks have peacefully coexisted for over five years and thus, there is no, or perhaps only a *de minimis*, risk of consumer confusion.

VI. CONCLUSION

For the reasons set forth above, it is requested that the refusal to register be reversed.

Respectfully submitted,

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